

Application No. 10/821,640

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DEC 21 2006REMARKS

Claims 6 and 48 have been amended to correct typos pointed out by the Examiner.  
Claims 1-56 are pending in the application.

**Response to Restriction Requirement/Election**

In the restriction requirement, the Examiner has required restriction to one of the following inventions under 35 U.S.C. §121.

Group I-claims 1-6, 23-24, 36-40, 47-52, 55 and 56 drawn to bacteriophage, a composition/formulation comprising the bacteriophage and kits classified in class 435, subclass 235.1.

Group II-claims 7-10, drawn to a method of purifying a bacteriophage which is lytic for Methylobacteria classified in class 435, subclass 235.1 and class 435, subclass 252.1.

Group III-claims 11-12 drawn to a method of purifying a bacteriophage which is lytic for HBB, classified in class 435, subclass 235.1 and class 435 subclass 252.1.

Group IV-claims 13-22 drawn to a method of removing Methylobacteria from a plant using a bacteriophage, a method of producing male sterility in a plant using a bacteriophage and a method of obtaining hybrid seeds of a plant using a bacteriophage, classified in class 435, subclass 235.1 and class 435, subclass 252.1.

Group V-claims 25-35 drawn to a method of treating a Methylobacteria or HBB infection in a patient and a method of treating an HBB associated autoimmune disease in a patient using a bacteriophage classified in class 435, subclass 235.1 and class 435, subclass 252.1.

Group VI-claims 41-46 drawn to a method of disinfecting an environmental surface contaminated with Methylobacterial or HBB using a bacteriophage classified in class 435, subclass 235.1 and class 435, subclass 252.1.

Group VII-claims 53 and 54 drawn to a method of making a medicament containing a bacteriophage classified in class 435, subclass 235.1.

Responsive to the Restriction Requirement, Applicants elect, with traverse, the invention of Group I. Applicants' grounds for traversal are set forth below.

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The Examiner states that Inventions I, II and III are related as a process of making and product made. The Examiner states, citing MPEP 806.05(f), that the inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process. The Examiner states that in the instant case, the claimed method i.e. obtaining bacteriophage from a sample can be used to produce other types of bacteriophage, e.g. lambda phage. Applicant is uncertain why the Examiner considers a lambda phage which is lytic for *Methylobacterium* to be a materially different product than that which is claimed in claim 1. Applicants respectfully submit, that a lambda phage that is purified by the process of claims 7 and 11 and that is lytic for a *Methylobacterium* as is required by the steps of the claims 7 and 11 is indeed within the scope of a bacteriophage as claimed in claim 1. Therefore, the Examiner has not established that the claims of Groups I, II and III are distinct.

The Examiner further states that searching of inventions of Groups I to III would impose a serious search burden because while the Groups can be identically classified, a separate search is required for each group because of a separate status in the art. The Examiner has not provided any evidence or discussion to show that the inventions have a separate status in the art. Applicants respectfully submit that the fact that the Examiner can articulate a search strategy that would be cumbersome to perform (i.e. a search of each Group separately) fails to satisfy the Patent Office's burden. In accordance with MPEP 803:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, §  
\*806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - §  
\*806.05(j)); and

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(B) There <sup>\*</sup>>would< be a serious burden on the examiner if restriction is >not< required (see MPEP § 803.02, <sup>\*\*</sup>> § 808<, and § 808.02).

The Examiner has not established that the inventions of Groups I, II and III are independent or distinct as discussed above, nor has the Examiner established a serious burden. The restriction is improper.

The Examiner states that the inventions of Groups I, and IV -VII are related as product and process of use. The Examiner states, citing MPEP 806.05(f), that the inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process. The Examiner states that in the instant case, antibiotics against Methylobacterial and HBB can be used to remove methylobacteria from a plant to produce male-sterile plants by reducing or eliminating the presence of Methylobacterial on the plant, to obtain hybrid seeds of a plant, to treat patients and disinfect a surface. However, the methods of claims of Groups IV-VII require the use of a bacteriophage lytic for Methylobacteria having equivalent scope to the bacteriophage of claim 1. Thus the Examiner's example of an antibiotic can not satisfy this test. Thus for all of the reasons stated above, the Examiner has not established that the inventions of Groups I and IV-VII are independent or distinct nor has the Examiner established a serious burden. Therefore the restriction is improper.

The Examiner argues that the inventions of Groups II-VII are drawn to independent and distinct methods which differ in the method objectives, method steps, in the reagents used and have different final outcomes. The Examiner then simply recites what each group of claims is drawn to without any discussion or support describing why the methods of each of these groups is independent or distinct.

The Examiner further states that a separate search is required for each of Groups II-VII as the search of any one Group is not required for any other Group. As discussed above, the Examiner's claim that there is a serious burden is not supported. The Examiner has not provided any support showing the necessity of separate searches. The most relevant search for the claimed inventions of Groups I-VII is a search of a bacteriophage lytic for Methylobacterium as classified in class 435. This single search

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will necessarily bring up methods of obtaining and methods of using such bacteriophage as is clear from the classification of Groups I-VII into identical classes. The Examiner has not provided any evidence as to why separate searches are necessary.

In view of the above, the restriction of the claims is improper. Withdrawal of the restriction requirement is respectfully requested.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 251-3509.

Respectfully submitted,

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